

Remarks

In the Action, claims 1-29, 31 and 36-41 were pending. Upon entry of the present paper, claim 2 is canceled without prejudice or disclaimer, claims 1, 3-29, 31 and 36-41 remain pending, and claim 42 is added. Applicants submit that the present paper does not introduce new matter into the specification, as support may be found, for example, at pages 15-17. The Action's rejections are as follows:

1. Claims 1, 3-12, 16-17 and 25-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the alleged combination of *Ford et al.* and *Hoerner et al.* (U.S. Pat. No. 5,751,134).
2. Claims 2 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the alleged three-way combination of *Ford et al.*, *Hoerner et al.*, and *Stevens, III* (U.S. Pat. No. 5,769,643).
3. Claims 13-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the alleged three-way combination of *Ford et al.*, *Hoerner et al.*, and *Prewitt* (U.S. Pat. No. 6,421,525).
4. Claims 19-21, 24, 29, 31 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ford et al.* in combination with *Bastian II* (U.S. Pat. No. 6,650,225)¹.
5. Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Ford et al.*, *Hoerner et al.*, and *Jenkins, Jr.* (U.S. Pat. No. 6,493,217).

¹ The Action lists the patent number for *Bastian II* as "US 6,421,525," a number that actually corresponds to the *Prewitt* patent addressed earlier in the Action. Action, paragraph 6. From the Action's Notice of References Cited, Applicants understand that the *Bastian II* referred to in the Action is actually U.S. Pat. No. 6,650,225.

6. Claims 22-23 and 38-41 stand rejected under 35 U.S.C. §103(a) as being unpatenable over the combination of *Ford et al.*, *Bastian II*, and *Prewitt*.

Applicants address these rejections in the sections that follow.

Independent Claims 19 and 29, and Dependent Claims 20-24, 31, 36 and 38-42

The Action's rejections of independent claims 19 and 29, and their dependent claims 20-24, 31, 36 and 38-41, rely on *Bastian II*. From the dates appearing on its face, *Bastian II* is a United States patent that was first filed on Dec. 11, 2000, and was published on Jun. 13, 2002. The present application claims priority to U.S. Provisional Application Serial No. 60/222,286 (filed on August 1, 2000), and 60/251,474 (filed on December 6, 2000). Accordingly, Applicants respectfully submit that *Bastian II* is not prior art to this application, and that the Action's reliance on *Bastian II* is in error. Applicants respectfully request reconsideration and withdrawal of the rejections that rely on *Bastian II*, and since all of the rejections of these claims rely on *Bastian II*, Applicants respectfully request allowance of independent claims 19 and 29, and their dependent claims (including newly-added claim 42, which depends from claim 19).

Independent Claim 1, and Dependent Claims 3-18

In rejecting independent claim 1, the Action relies on the same combination of *Ford et al.* and *Hoerner et al.* used in the previous Office Action (paper no. 14). As an initial matter regarding this alleged combination, and as noted in Applicants' previous Amendment (paper no. 15), there is no motivation or suggestion for combining these two references in the manner suggested by the Action. The MPEP summarizes the requirements for an obviousness combination as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP §2143 (emphasis added). Accordingly, the Action's proposed combination of *Ford et al.* and *Hoerner et al.* is only proper if there is some suggestion or motivation for making this combination.

Here, there simply is no reason why anyone of ordinary skill would seek to combine *Ford et al.* and *Hoerner et al.* in the manner proposed in the Action. *Hoerner et al.* relates to a system for controlling how rechargeable batteries are recharged, and for providing a user with a visible indication (via a "gas gauge") as to how charged the battery is. *See, e.g., Hoerner et al.* Fig. 4 (gauge) and Figs. 5-9 (charging process). *Hoerner et al.* controls the battery charging by measuring the battery's temperature (col. 5, lines 52-64), and by making sure to completely discharge the battery before charging it (col. 3, lines 11-14). The other half of the Action's proposed combination, *Ford et al.*, relates to a mobile laboratory having experimental devices, such as "laboratory balances, microscopes, thermometers, water baths, pulse-rate meters, or robotic assemblies." *Ford et al.*, col. 7, lines 7-9.

Ford et al. has no use for *Hoerner et al.*'s rechargeable battery, or its battery-charging gauge. The *Ford et al.* laboratory already has its own AC power socket 45 and DC power socket 44 to supply electricity to the variety of devices (e.g., microscopes, pulse-rate meters, robotic assemblies, etc.), so there would be nothing gained by incorporating *Hoerner et al.*'s battery in any of these devices, and *Ford et al.* never suggests that a battery would be desirable. Indeed, the very first step in the *Ford et al.* process diagram requires the user to "[p]lug power cord into

wall socket.” *Ford et al.* Fig. 6. *Ford et al.* simply has no use at all for the *Hoerner et al.* rechargeable battery gauge, and there is no reason why anyone would seek to combine these two references in the manner suggested.

To support its combination, the Action alleges that “[i]t is well within the skill of one of ordinary skill in the art to provide a plurality of devices with an equivalent plurality of rechargeable batteries (claims 1 and 25) and to provide a plurality of spares (claim 1) that are recharged simultaneously to provide for battery backup and power recovery functions.” Action, p. 3. It is inappropriate to rely on a “level of skill” to provide a motivation for combining references. MPEP §2143.01 (“A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” (underlined emphasis in original, double underlined emphasis added). In order to make the combination, there must be some logical, objective reason for the combination. Here, no such reason exists. A system that has to be plugged into a wall socket and has its own DC power supply (*Ford et al.*) has no use for rechargeable batteries at all, and certainly no use for “spare” rechargeable batteries. There is no objective reason for the Action’s alleged combination.

Even assuming, *arguendo*, that the alleged combination is made, the result still would not teach or suggest the system recited in amended claim 1. Claim 1 recites, among other features, the following:

a battery storage area in said portable cart, storing a plurality of spare rechargeable batteries for said computers;

a power supply in said portable cart, wherein said power supply recharges said plurality of rechargeable batteries

Neither *Ford et al.* nor *Hoerner et al.*, alone or in combination, discloses the “battery storage area” recited in this claim. Furthermore, Applicants have amended the claim to recite the following:

a wireless communication server in said portable cart, wherein said server is communicatively coupled to said plurality of portable computers via wireless communications when said portable computers are removed from said cart and distributed among a plurality of students for a teaching session, and wherein said shelves store said portable computers when said portable computers are returned to said cart after said teaching session.

The alleged combination of *Ford et al.* and *Hoerner et al.* still does not disclose either the “wireless communication server,” or that “said server is communicatively coupled to said plurality of portable computers via wireless communications when said portable computers are removed from said cart and distributed among a plurality of students for a teaching session, and wherein said shelves store said portable computers when said portable computers are returned to said cart after said teaching session.” Instead, *Ford et al.* has all of its components permanently preconfigured with the interactive devices 17 and experimental devices 19 attached to the cart, a feature which *Ford et al.* prefers because it avoids having to go through installation or setup. *Ford et al.*, col. 4, line 67 to col. 5, line 1 (“permanently pre-configured eliminating installation or setup”).

For at least these reasons, Applicants submit that amended independent claim 1 distinguishes over *Ford et al.* and *Hoerner et al.* None of the other cited references overcomes the deficiencies in *Ford et al.* and *Hoerner et al.*, and Applicants submit that the claim is in condition for allowance. Dependent claims 3-18 depend from claim 1, and are allowable for at least the same reasons as claim 1, and further in view of the various advantageous and novel

features recited therein. For example, claim 7 recites “[t]he system of claim 1, wherein said battery storage area is a drawer located above said one or more shelves.” The Action alleges that *Ford et al.*, Fig. 1, shows the recited drawer, with the exception of a drawer having batteries. Action, p. 4. The claim 7 drawer is located above said one or more shelves. This placement of the drawers may be advantageous for heat dissipation purposes. Looking at the cited *Ford et al.* Fig. 1, no such drawers are shown. At best, *Ford et al.* discloses receptacle 16 and enclosed receptacle 14, but fails to disclose the recited drawers as claimed.

As another example, dependent claim 13 recites “[t]he system of claim 1, wherein said plurality of computers includes student computers, and wherein said server is communicatively coupled to a teacher computer.” The Action concedes that “Ford et al. does not disclose nor does Hoerner et al. teach that the student computers are communicatively coupled to a teacher computer.” Action, p. 6. To address this deficiency, the Action introduces yet another patent into the mix: *Prewitt*, but as will be discussed below, there is no proper motivation or suggestion for this three-way combination.

Prewitt describes a computer system that is used on a school bus to educate children while on their way to/from school, or on field trips. See, e.g., *Prewitt*, col. 1, lines 27-28; col. 2, lines 27-34; and Figs. 2-3. To accommodate the school bus environment, the *Prewitt* system includes ruggedized equipment to sustain the vibrations caused by the school bus (col. 3, lines 9-11); an ambient light sensor to control the brightness of the display based on the amount of ambient light (col. 3, lines 35-39); an audio amplifier to make the audio volume louder if the ambient noise is higher (col. 3, lines 39-48); an audio cutoff switch to allow the bus driver to disable all audio (col. 3, lines 61-64); a global positioning system (GPS, col. 4, lines 19-30); and a specialized power supply to power the system from the school bus’ existing electrical system

(col. 4, lines 31-34). There is no objective, logical reason why anyone would combine the *Prewitt* school bus system with either *Ford et al.* or *Hoerner et al.* *Prewitt* has its own power supply (col. 4, lines 31-37), so there is no need for *Hoerner et al.*'s rechargeable battery. *Prewitt*'s system is on a school bus, perhaps the last place a student would ever want to run an experiment using a microscope or balance, as used in *Ford et al.* There is no objective support for this combination.

Independent Claim 25, and Dependent Claims 26-28 and 37

Independent claim 25 recites, among other features, "a plurality of laptop computers, stored on one or more shelves in said cart; and a plurality of rechargeable batteries for said laptop computers, stored in a battery area of said cart, wherein said batteries are recharged during storage in said cart." The Action rejects claim 25 based on the alleged combination of *Ford et al.* and *Hoerner et al.* Action, p. 4.

At the outset, and as discussed above, Applicants note that there is no proper motivation for combining *Hoerner et al.* (which relates to recharging batteries) with *Ford et al.* (which has no batteries in the first place). Even assuming, *arguendo*, that such a combination would have occurred to one of ordinary skill, the resulting combination still would not have resulted in the claim 25 system. For example, claim 25 recites "a plurality of laptop computers, stored on one or more shelves in said cart." The Action cites *Ford et al.* Fig. 5 to show the plurality of laptop computers. Action, p. 3. *Ford et al.* Fig. 5 does not show any such plurality of laptop computers. The only components shown there are phone line connector 34, phone line connector spool 50, modem 51, interactive device 17, signal socket 43, power/signals unit 42, signal connection 52, power connection 53 and experimental device 19 (depicted as a scale). *Ford et al.* Fig. 5, col. 6, lines 1-25. None of these is described as a laptop computer. The *Hoerner et al.*

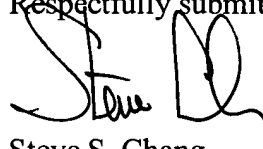
rechargeable battery gauge would not, even if used in *Ford et al.* as alleged, result in a “plurality of laptop computers,” as recited in claim 25.

Claim 25 distinguishes over the applied references, and is in condition for allowance. Claims 26-28 and 37 depend from claim 25, and are allowable for at least the same reasons as claim 25, and further in view of the various advantageous and novel features recited therein. For example, new claim 37 recites “[t]he system of claim 25, wherein said battery area includes a plurality of molded slots to assist in the proper seating of said batteries.” None of the cited references show such features.

Conclusion

For at least the reasons state above, Applicants submit that the pending claims 1, 3-29, 31, and 36-42 are distinguishable over the applied references, and are in condition for allowance. If the Examiner feels that further discussion and/or amendment is necessary to place the application in condition for allowance, the Examiner is invited to telephone Ms. Peggi McConnell of Earthwalk Communications (assignee of the present application), with whom the Examiner has recently corresponded, at (888) 213-4900 x230.

Respectfully submitted,



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